

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No: 09/802,481
Applicant: Paul Willard et al.
Filed: 03/09/2001
Title: Customized Credit Offer Strategy Based on Terms Specified By An Applicant
Art Unit: 3692
Examiner: Subramanian, Narayanswamy
Docket: 132538-1014
Customer No.: **32914**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY UNDER 37 C.F.R. §1.111

Sir:

This reply is in response to the Office Action mailed February 23, 2007. No amendments are being made to the application in connection with this reply.

Applicants respectfully traverse the rejections of all claims under §101 and §112, second paragraph. They are in error for reasons detailed below. Withdrawal of these rejections is respectfully requested.

Rejection under §112, second paragraph

According to Section 2103.02 of the Manual for Patent Examination Procedure (8th ed. August, 2006),

If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be

appropriate. See Morton Int'l, Inc. v. Cardinal Chem. Co., 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.

It is respectfully submitted that a person of ordinary skill in the art could interpret the rejected claims so as to understand how to avoid infringement. There is nothing ambiguous about the interpretation of the meaning of the claim: a selected offer is transmitted to the applicant when at least one of the set of offers meets all of the requested terms or if no offers include all of the requested terms, then an offer that meets at least one of the preferred requested terms is transmitted. Not specifying what happens when it is determined that none of the set of offers meets all of the requested terms and further none of the set of offers meets at least one preferred requirement is not necessary to enable interpretation to avoid infringement. Therefore, it is submitted that omissions of an "if not" statement does not render the claims indefinite, and that the claims meet the statutory requirements.

Section 101 Rejection

It is respectfully submitted that claims 1-14 are directed to statutory subject matter. According to Section 2106 of the Manual for Patent Examination Procedure (8th ed. August, 2006),

For purposes of an eligibility analysis, a physical transformation "is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application." AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. If USPTO personnel determine that the claim does not entail the transformation of an article, then USPTO personnel shall review the claim to determine if it produces a useful, tangible, and concrete result. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is "useful, tangible, and concrete."

It is respectfully submitted that a tangible, concrete and useful result is produced by the claimed method. The examiner contends that the result is not repeatable or reproducible, and thus it cannot be "concrete." However, this is simply not correct. If either of two criteria is met,

an offer transmission is made. Each time the process is followed, the transmission is made. The result is reproduced each time. The result is plainly concrete.

Therefore, it is submitted that this rejection is in error for at least these reasons and must be withdrawn.

In view of the remarks, applicants respectfully submit that the application is in allowable form. Accordingly, applicants respectfully request reconsideration and allowance.

Applicant hereby authorizes the Commissioner to charge any fees due but not submitted with this paper to Deposit Account No. 07-0153. The Examiner is respectfully requested to call Applicant's Attorney for any reasons that would advance the current application to issue. Please reference new Attorney Docket No. 132538-1016.

Dated: August 23, 2007

Respectfully submitted,
GARDERE WYNNE SEWELL LLP

/Marc A. Hubbard/
Marc A. Hubbard
Registration No. 32,506
ATTORNEY FOR APPLICANT

3000 Thanksgiving Tower
1601 Elm Street
Dallas, Texas 75201-4761
(214) 999-4880 - Telephone
(214) 999-3880 - Facsimile